

## REMARKS

### *I. Introduction*

Claims 21-22, 25-27 are pending in the present application. In response to the Office Action dated October 21, 2002, applicants have amended claim 21, canceled claims 23-24, and introduced new claims 25-27. For the reasons below, applicants believe they have sufficiently addressed the examiner's concerns, and respectfully solicit the application to issue.

### *II. Amendment of Claims in Response to 35 U.S.C. §102(e) Rejections*

The examiner rejected claims 21-24 under 35 U.S.C. §102(e) as being anticipated by Narang *et al.* (US 5,830,600). Applicants have amended the claims in response to that rejection. As discussed below, Narang *et al.* do not now anticipate the presently claimed invention.

#### *A. The Standards for Anticipation*

A prior art reference anticipates a claimed invention only if there is strict identity between the two. Specifically, to anticipate a claim, each and every element as set forth in the claim must be found, either expressly or inherently described, in a prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) (cited at MPEP §2131).

However, there are certain limitations to the aforementioned general rule. For instance, a prior art genus does not necessarily anticipate a later claimed species. See *In re Meyer*, 599 F.2d 1026, 202 USPQ 175 (CCPA 1979). The MPEP states that a generic chemical formula will anticipate a claimed species covered by the formula only when the species can be "at once envisaged" from the formula. MPEP §2131.02.

Narang *et al.* do not anticipate any pending claims either through strict identity, or as a prior art genus that can at once envisage a species.

#### B. The Narang *et al.* Reference

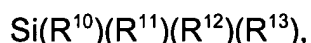
Narang *et al.* teach nonflammable and self-extinguishing electrolytes for batteries. The electrolyte compositions comprise lithium salts dissolved in a fire-retardant solvent selected from the group consisting of a phosphate, a phospholane, a cyclophosphazene, a silane, a fluorinated carbonate, a fluorinated polyether and mixtures thereof.

For example, Narang *et al.* define a fire-retardant phosphate solvent as having the following structure:



wherein  $\text{R}^1$ ,  $\text{R}^2$  and  $\text{R}^3$  are independently selected from the group consisting of e.g.,  $\text{C}_1$ - $\text{C}_6$  alkyl terminally substituted with 0 to 3 halogen atoms and containing 0 to 3 ether linkages.

As another solvent, Narang *et al.* specify a silane having the following structure:



wherein  $\text{R}^{10}$ ,  $\text{R}^{11}$ ,  $\text{R}^{12}$ ,  $\text{R}^{13}$  are independently selected from the group consisting of e.g.,  $\text{C}_1$ - $\text{C}_6$  alkyl terminally substituted with 0 to 3 halogen atoms and containing 0 to 3 ether linkages (column 4, lines 38 to 49).

#### C. The Present Invention Cannot at Once Be Envisaged From Narang *et al.*

The present application constitutes a selection invention of Narang *et al.* That is, certain claimed compositions are a species of the generic formulae in Narang *et al.* As discussed above, a species is anticipated only if it can be at once envisaged from a

prior art reference. However, Narang *et al.* cannot be used to once envisage any pending claim.

Narang *et al.* offer a huge amount of possible solvents. And an ordinary person skilled in the art has to select a solvent of his or her own choice out of all solvents disclosed by Narang *et al.* Thereafter, the person has to combine the solvent with one of many electrolyte salts which are disclosed by Narang *et al.* (column 10, lines 17 to 25). Narang *et al.* mention as preferred salts  $\text{LiPF}_6$ ,  $\text{LiAsF}_6$ ,  $\text{LiN}(\text{SO}_2\text{CF}_3)_2$  and mixtures thereof. Besides, Narang *et al.* is silent as to a mixture of  $\text{LiBF}_4$  with another lithium salt. Further, in all detailed examples, Narang *et al.* use different solvents in combination with different lithium salts as claimed in the present application.

Applying the standards for anticipation to each individual pending claim shows that Narang *et al.* do not anticipate any claim.

#### D. Currently Amended Claim 21 and New Claim 25

Currently amended claim 21 of the present application covers a composition, which comprises at least one solvent from the group consisting of a boronic acid ester, a carbonate, a sulfate or a silane, wherein methoxy ethyl group is used as a substituent. New claim 25 covers the same solvents with the exception of silane.

Narang *et al.* do not mention at all a boronic acid ester, a carbonate, or a sulfate, which are elements of claims 21 and 25. Because there is no strict identity (i.e. identity of *all* elements) between Narang *et al.* and claims 21 and 25, Narang *et al.* does not anticipate those claims.

Consequently, claims 21 and 25 are considered novel over Narang *et al.*

E. New Claim 26

New claim 26 covers a composition comprising  $\text{OP}(-\text{OCH}_2\text{CH}_2\text{OCH}_3)_3$  and a conducting salt  $\text{LiBF}_4$ . This composition is a species that cannot be at once envisaged from the Narang *et al.* genera.

In all detailed examples, Narang *et al.* disclose an electrolyte consisting of  $\text{LiPF}_6$  in tris-(methoxyethyl)-phosphate (TMEP). No example is given by Narang *et al.* in which this solvent is also used with another conducting salt as  $\text{LiBF}_4$ . Therefore, a person skilled in the art has to select the claimed combination of solvent and conducting salt of the present invention out of all those electrolyte salts mentioned in the general part of the specification of Narang *et al.*

Consequently, claim 26 is considered novel over Narang *et al.*

F. New Claim 27

New Claim 27 covers a composition comprising  $\text{Si}(\text{OCH}_2\text{CH}_2\text{OCH}_3)_4$  and a conducting salt  $\text{LiBF}_4$  and  $\text{LiPF}_6$ . Again, this composition is a species that cannot be at once envisaged from the Narang *et al.* genera.

Like new claim 26 above, the combination of this silane solvent and conducting salt is also not mentioned in the examples of Narang *et al.*

Consequently, claim 27 is considered novel over Narang *et al.*

*III. Conclusion*

In view of the foregoing amendment and remarks, applicants consider that the rejections of record have been obviated and respectfully solicit passage of the application to issue.

**A check in the amount of \$110.00 is attached to cover the required one month extension fee.**

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11-0345. Please credit any excess fees to such deposit account.

Respectfully submitted,  
KEIL & WEINKAUF

A handwritten signature in black ink, appearing to read 'H. B. Keil', written in a cursive style.

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